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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/325,549 10/18/94 BARBERG

D B560.120002

NGUYEN, J. EXAMINER

CSM1/0710

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ART UNIT	PAPER NUMBER
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3503

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DATE MAILED: 07/10/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on April 6, 1995 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-11 and 15-37 are pending in the application.
Of the above, claims 3-11, 23, 25, 27-32, and 35 are withdrawn from consideration.
2. ☒ Claims 12-14 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1, 2, 15-17, 18-22, 24, 26, 33, 34, 36, and 37 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Claims 3-11 stand withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected species. Election was made **without** traverse in Paper No. 7.

Claims 23, 25, 27-32, and 35 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected species. Election was made **without** traverse in Paper No. 7.

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the locking rim which surrounds the rim of the container (claim 1), the handle of claim 18, the wire of claim 20, the hose of claim 21, and the bearing balls of claim 24 must be shown or the feature cancelled from the claims. **No new matter should be entered.**

Applicant is required to submit a proposed drawing correction in response to this Office action. However, correction of the noted defect can be deferred until the application is allowed by the examiner.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using

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it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed, i.e., for the retainer to be "releasably coupled to the container" or for the rim to "releasably" engage the rim of the container.

Claims 1, 2, 15, 16 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 1, 2, 15-22, 24, 26, 33, 34, 36 and 37 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A few examples are cited below; **all claims** should be revised carefully to correct other similar deficiencies.

For clarity and definiteness, it appears that --an exterior of-- should be inserted before "the base" (claims 33, line 1, and claim 37, line 5 from bottom).

The following are **not clear**: "hole defined by the side wall" (how?) (throughout the claims), "to receive" (is the entire

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elongate flexible member being received?) (claims 19-21),
"therebetween" (where?).

The following appear to **lack antecedent basis**: "the flat surface" (claim 15), "the bottom plate" and "the top" (claim 24), "the top plate" (claim 34).

The claims reciting the following **functions** lack recitation of sufficient structures/elements and/or necessary structural cooperation between the structures/elements to enable the functions to be effected: "to hold the spool within the container" (claim 1, line 2 from bottom) (the container only has one base which can be square and one side wall which can be a straight wall), "retains the elongate flexible member concentrically ... column" (claim 18, lines 17-18), "passes ... through the second access hole" (claim 22, line 3), "passes through the cavity... spool" (claim 36, last two lines).

In claim 1: **what** is "in a horizontal orientation"?

In claim 17, what is "concentrically" relative to? Note that the container only has one base which can be square and one side wall which can be a straight wall).

In claim 18, line 9, "for freely resting" is an incomplete phrase.

In claim 24, what is the purpose of the second bearing unit?

In claim 26, "extending through" is an incomplete phrase and "and a substantial ...the spool" (lines 2-3) makes little sense.

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In claim 34, how does the disk defines the second access hole?

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, and 15-17 are rejected under 35 U.S.C. § 103 as being unpatentable over Harrill in view of Chong and Schwartz.

Harrill discloses a container having a rotatably mounted spool 10 having substantially all the claimed features except for the locking rim and the foot plate. Chong discloses a similar apparatus in which a spool is supported inside a bucket 16 comprising a bottom 26 and a ball bearing assembly 28. Note the foot plate 10. Schwartz discloses another similar device in which a reel 18 is contained in a housing comprising overlapping edges 39A and 39B to overlap a portion of the reel. It would have been obvious to a person having ordinary skill in the art to provide the apparatus of Harrill with a foot plate as taught by Chong to support and stabilize the device and with an overlapping rim as taught by Schwartz to hold the spool within the container. It would also have been obvious to a person having ordinary skill in the art to omit the screw 54 of Harrill so that the spool may be readily removed from the container as it is well established that omission of an element and its function where not needed is obvious and to provide the foot plate with mounting holes to

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facilitate mounting. The disposition of the mounting holes would have been an obvious matter of design choice to a person having ordinary skill in the art based on factors such as preference, space optimization, and costs.

Claims 18-22, 24, 26, 33, 34, 36, and 37 are rejected under 35 U.S.C. § 103 as being unpatentable over Chong in view of Harrill.

Chong and Harrill have been advanced above. It would have been obvious to a person having ordinary skill in the art to alternatively provide spool of Chong as the one taught by Harrill to facilitate removal of the spool from the container and to provide the device of Chong with a handle as taught by Harrill (note handle 64) to facilitate handling.

Claims 1, 2, and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 19, 22, and 24 of copending application Serial No. 08/325,552. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the instant claims are encompassed in the above claims of the copending application.

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This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Applicant's arguments filed April 6, 1995 have been fully considered but they are not deemed to be persuasive.

It should be noted that the interview of March 10, 1995 was for copending serial number 08/325,552, not the instant application.

It should be noted that the bottom of end wall 40 of Harrill constitute "a bottom" as claimed and that the surface 20 is part of the base of the container. It is further noted that the fastener 54 is used to retain the spool to the container and that with or without the fastener, the spool is rotatable in the container.

The newly added claims 18-37 are treated as newly added claims. It should be noted that where these claims come from is irrelevant because all claims must be interpreted in view of the instant specification. Therefore, the arguments of those

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claims 18-37 referring to another application have not been further considered.

The provisional obviousness-type double patenting rejection stands because the copending application 08/325,552 is still pending; it must be expressly abandoned if applicant does not intend to further pursue that application and if this rejection is to be avoided. It should be noted that the copending application is 08/325,552 and not 08/325,549 as noted by applicant.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

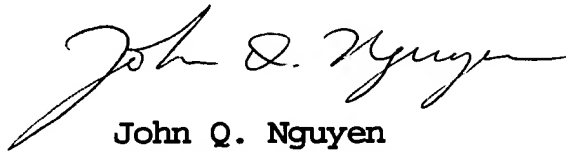
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Nguyen whose telephone number is (703) 308-2689.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

A handwritten signature in cursive script, reading "John Q. Nguyen". The signature is written in dark ink and is positioned above the printed name and title.

John Q. Nguyen
PRIMARY Examiner
Group 3500